



UNITED STATES
PATENT AND
TRADEMARK OFFICE

25

SEP - 2 2003

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
PO BOX 1450, ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

KRISTINA BIEKER-BRADY, PH.D
CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON MA 02110

In re Application of :
John S. Haurum et al :
Serial No.: 09/866,573 : PETITION DECISION
Filed: May 25, 2001 :
Attorney Docket No.: 50190/005001 :

This is a decision on the petition under 37 CFR 1.181, filed July 24, 2003, requesting withdrawal of the finality of an Office action.

BACKGROUND

A review of the file history shows that the first examiner mailed a first Office action to applicants on November 26, 2001, in which an eight-way restriction requirement was set forth. Applicants replied on January 22, 2002, electing Group I, claims 1-2 and 5-14, with traverse. Applicants also canceled claims 2-4 and 15-22 and added claims 25-34.

The examiner mailed a new Office action to applicants on March 7, 2002, setting a three month shortened statutory period for reply, maintaining the restriction requirement and making it Final. Elected claims 1 and 5-14 were rejected under 35 U.S.C. 112, first paragraph for non-enablement and lack of support in the specification of the claimed composition. Claims 1, 5 and 9-12 were rejected under 35 U.S.C. 102(b) as anticipated by US Patent 5,789,208 (Sharon). Claims 1, 6-8 and 13-14 were rejected under 35 U.S.C. 103(a) as unpatentable over Sharon in view of US Patent 5,670,626 (Chang). Claim 9 was rejected under 35 U.S.C. 103(a) as unpatentable over Sharon in view of WO 96/09085. Claims 10-12 were objected to as depending from a canceled claim.

Applicants, through a new attorney, replied on June 24, 2002, by amending claims 1 and 10 and added claims 35-49. The rejections were responded to in an appropriate manner.

A new examiner mailed a new non-final Office action to applicants on October 2, 2003, requiring an election of species only between antigens. Applicants replied on November 15, 2002, electing a single species without traverse.

The examiner mailed a new Office action to applicants on January 28, 2003, and rejected claims 1, 5-14, 35 and 39-49 under 35 U.S.C. 103(a) as unpatentable over US Patent 4,740,371 (St Remy et al) in view of Sharon. The examiner made the action Final arguing that the applicants' actions and amendments had made the new ground of rejection necessary.

Applicants filed an Amendment after Final rejection on April 28, 2003, proposing cancellation of claims 5 and 23-34 and amendment of claim 1. The examiner denied entry of the amendment in an Advisory Action mailed July 7, 2003, on the basis that pending claim 7 would depend on a canceled claim if the amendment were entered.

Applicants replied by filing a Notice of Appeal and this petition on July 24, 2003, with the required extension of time and fee therefor.

DISCUSSION

Applicants argue in the petition that the amendment to claim 1 served to narrow the scope of the claim so as to avoid the teachings of the Sharon reference applied under 35 U.S.C. 102(b) or 35 U.S.C. 103 and that any rejection for obviousness asserted against the more narrow claim could have been asserted against the broader claim. It is noted that the St Remy et al reference applied as a new reference in the Final Office action was supplied by applicants in an Information Disclosure Statement on September 7, 2001, but was never applied against the claims in any prior Office action. It is further noted that the Sharon reference is directed to Polyclonal Libraries, and specifically to tumor specific antigens whereas St Remy et al is directed to Allergy Treatment and antibodies useful in treating allergy antigens. Thus it would have been logical to initially use a reference specifically directed to allergy treatment using polyclonal antibodies against an application specifically directed to polyclonal antibody compositions for treatment of allergy. The original examiner failed to do so, but used a more generic reference directed primarily, if not exclusively, to polyclonal antibodies for tumor specific antigens. The new examiner then used the more logical primary reference already of record, but not applied, St Remy et al, as the primary reference when applicants narrowed their claims in an expected manner. Such deprives applicants of a full opportunity to reply to such a rejection.

DECISION

Applicants' petition is **GRANTED**.

The Finality of the last Office action is withdrawn. The reply filed April 28, 2003, will be considered a reply to a non-Final Office action and will be entered. The application will be forwarded to the examiner for further consideration. The Notice of Appeal will be held in abeyance. Should a new Final Office action be mailed by the examiner the Notice may be reinstated without additional fee, if desired.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

A handwritten signature in cursive script that reads "Jasmine C. Chambers".

Jasmine C. Chambers
Director, Technology Center 1600